

Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

The specification has been amended to update various references to patent applications with corresponding patent numbers. Entry of these amendments to the specification is respectfully requested.

Claims 1-13, 16-31 and 34-38 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over "First Internet Backgammon Server 1994 (FIBS)" in view of Instant Messaging Guide 1996 (IMG). While not acquiescing in this rejection, claims 1, 10, and 28 have been amended. As such, the applied references are discussed below with reference to the amended claims.

FIBS is an internet backgammon server that allows internet users to play backgammon in real-time against other players logged into the server. FIBS is quite different than the subject matter set forth in pending claims. For example, FIBS involves a game running on a FIBS server to which users connect. In contrast, claim 1, for example, specifies at least two video game systems executing respective game programs, wherein each video game system is configured to connect to a web server computer via the Internet and to communicate status data indicative of a game played on the video game system by a user thereof. FIBS does not disclose such video game systems nor does FIBS provide any disclosure or suggestion of a such a video game system communicating data indicative of a game played on the video game system to a server. In addition, the chat and player status features described in FIBS are limited to one game and thus FIBS players cannot chat with or see the status of players who are playing, for example, chess or an auto racing game. Thus, FIBS does not provide status data of the other users on a user's buddy list if the user and the other users are playing different games as further specified in claim 1.

The IMG document does not remedy the deficiencies of FIBS. The IMG document describes instant messaging and various "popular" internet messaging clients. The instant messaging client described in the IMG document is a stand-alone client, and is not incorporated into a gaming program. There is no disclosure of determining the gaming status of one of the buddies in a buddy list. Furthermore, the client is not on a

game console. Thus, even if the "buddy list" concept of the IMG document were forcedly incorporated into the FIBS system, the subject matter of the claim 1 would not have resulted.

Claims 2-9 depend from claim 1 and would not have been rendered obvious by the proposed combination of FIBS and IMG because of their dependencies and because of the additional patentable features contained therein.

Independent claim 10 is directed to a portable memory medium having stored thereon an application executable by processing circuitry of a video game system connected to a communication network. The application comprises both video game program code for a video game and messaging service program code for a messaging service for communicating messages to other messaging service users connected to the communication network, whereby the messaging service is accessible when the application is executed by the processing circuitry of the video game system. As noted above, the FIBS document describes a game running on a server to which players connect to play backgammon. There is no disclosure therein of a portable memory medium or of a video game system connected to a communication network. There is also no disclosure or suggestion of an application that comprises both video game program code and messaging service program code. The deficiencies of FIBS are not remedied by the IMG document which, as noted above, discloses various messaging clients, but does not disclose or suggest providing messaging service program code and video game program code in a single application. For at least these reasons, the proposed combination of FIBS and the IMG document would not have rendered the subject matter of claim 10 obvious.

Claims 11-13 and 16-27 depend from claim 10 and would not have been rendered obvious by the proposed combination of FIBS and the IMG document because of their dependencies and because of the additional patentable features contained therein. For example, the office action alleges without reference to any documentary evidence that it would have been obvious to use images as specified in claims 20 and 21. Such a rejection improperly dispenses with the evidentiary requirements for an obviousness rejection. In addition, there is no disclosure or suggestion in either FIBS or the IMG

document of a sign-off alert. The office action references page 2 of the IMG document in this regard, but this page only mentions an alert when "a friend pops online."

Claim 28 is directed to a video game system that includes a connector that, in use, connects to a portable storage medium storing an application that comprises both video game program code for a video game and messaging service program code for a messaging service for communicating messages to other message service users connected to the communication network, whereby the messaging service is accessible when the stored application is executed by processing circuitry of the video game system. For the reasons discussed above with reference to claim 10, neither FIBS nor the IMG document, nor the proposed combination thereof, discloses or suggests an application that comprises both video game program code and messaging service program code. For at least this reason, the proposed combination of FIBS and the IMG document would not have rendered the subject matter of claim 28 obvious.

Claim 29 is directed to a video game machine comprising an application program executing system for executing an application program comprising a video game and a messaging service client. Here again, neither FIBS nor the IMG document, nor the proposed combination thereof, discloses or suggests an application that comprises both video game program code and messaging service program code. For at least this reason, the proposed combination of FIBS and the IMG document would not have rendered the subject matter of claim 29 obvious.

Claims 30, 31 and 34-38 depend from claim 29 and would not have been rendered obvious by the proposed combination of FIBS and the IMG document because of their dependencies and because of the additional patentable features contained therein.

Claims 14, 15, 32 and 33 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed FIBS-IMG document combination in view of Best (U.S. Patent No. 5,393,073). Best is cited in the office action for its disclosure of a game console or hand-held gaming device and the office action purports that it would have been obvious to modify the proposed FIBS-IMG combination to use either hand-held or console game machines. However, Best does not cure the deficiencies of FIBS and the IMG document with respect to claim 10 (from which claims 14 and 15 depend) or claim 29 (from which claims 32 and 33 depend). For at least these reasons, the proposed

Casey J. Pelkey *et al.*
Application No. 09/724,908

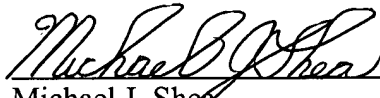
three-way combination of FIBS, the IMG document and Best would not have rendered the subject matter of claims 14, 15, 32 and 33 obvious.

New claims 39-52 have been added. The subject matter of these new claims is fully supported by the original disclosure and no new matter is added. These claims are believed to be allowable for reasons similar to those advanced above with respect to the already pending claims.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

A handwritten signature in cursive script, appearing to read "Michael J. Shea", is written over a horizontal line.

Michael J. Shea
Registration No. 34,725

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201
Telephone: (703) 816-4000 +4029
Facsimile: (703) 816-4100
MJS:mjs